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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,215	03/24/2006	Dieter Doehring	BARDP0126US	4813
23908 7590 10/13/2009 RENNER OTTO BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE NINETEENTH FLOOR CLEVELAND, OH 44115				
EXAMINER O HERN, BRENT T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/595,215

**Applicant(s)**

DOEHRING, DIETER

**Examiner**

Brent T. O'Hern

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/4/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 8-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8-11, 13, 14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/2009 has been entered.

#### ***Claims***

2. Claims 2-4, 8-14 and 16-20 are pending with claims 12-14 withdrawn and claims 19-20 new.

### **WITHDRAWN REJECTIONS**

3. All rejections of record in the Office action mailed 4/7/2009 have been withdrawn due to Applicant's amendments in the Paper filed 8/4/2009.

### **NEW REJECTIONS**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-4, 8-11 and 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "the outer being coating free of amino resin" in independent claim 19, line 6 is new matter as Applicant's Specification does not have support for the negative limitation.

6. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The phrase "wherein the silane adhesion promoter is an amino silane adhesion promoter" in dependent claim 16, lines 1-2 is vague and indefinite since it is unclear how the adhesion promoter can be an amino silane adhesion promoter while independent claim 19, line 6 states the coating is free of amino resin.

Clarification and/or correction required.

***Claim Rejections - 35 USC § 103***

8. Claims 2-4, 10-11 and 17-18 are is rejected under 35 U.S.C. 103(a) as obvious over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of O'Dell et al. (US 5,545,476).

Regarding claims 2-4,11 and 17-20, Dohring ('984) teaches paper for a laminate panel with a decorative paper provided with a décor and is impregnated with an amino

resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$  (90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide and containing corundum that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See col. 1, l. 47 to col. 2, l. 11 and Abstract.*), however, fails to expressly disclose the outer coating being free of amino resin per independent claim 19 and a three-layer structure per dependent claim 16.

However, O'Dell ('476) teaches a paper for a laminate with abrasion resistant particles coated with a silane adhesion promoter that is free of an amino resin (*See col. 6, ll. 42-48.*) for a structure having three or more layers (*See col. 4, ll. 4-26 and 42-58 and Abstract.*) for the purpose of providing an aesthetic laminate with better initial better wear resistance (*See col. 6, ll. 42-48 and Abstract.*).

Therefore, it would have been obvious to use an adhesion promoter that is free of an amino resin as taught by O'Dell ('476) in Dohring ('984) in order to provide an aesthetic laminate with better initial wear resistance.

Regarding claim 10, Dohring ('984) obviously teaches the abrasion resistant particles being in a plane (*See col. 1, l. 47 to col. 2, l. 11 and Abstract where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*).

9. Claims 2-4, 8-11 and 17-20 are rejected under 35 U.S.C. 103(a) as obvious over Dohring et al. (US 2003/0138600) in view of O'Dell et al. (US 5,545,476).

Regarding claims 2-4, 8-9, 11 and 17-20, Dohring ('600) teaches paper for a laminate panel with a decorative paper filled with an acrylate provided with a décor

having a weight of 20 to 60 g/m<sup>2</sup> and is impregnated with an amino resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$ /(90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide and containing corundum that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See paras. 20-31.*), however, fails to expressly disclose the outer coating being free of amino resin per independent claim 19 and a three-layer structure per dependent claim 16.

However, O'Dell ('476) teaches a paper for a laminate with abrasion resistant particles coated with a silane adhesion promoter that is free of an amino resin (*See col. 6, ll. 42-48.*) for a structure having three or more layers (*See col. 4, ll. 4-26 and 42-58 and Abstract.*) for the purpose of providing an aesthetic laminate with better initial better wear resistance (*See col. 6, ll. 42-48 and Abstract.*).

Therefore, it would have been obvious to use an adhesion promoter that is free of an amino resin as taught by O'Dell ('476) in Dohring ('600) in order to provide an aesthetic laminate with better initial wear resistance.

Regarding claim 10, Dohring ('600) obviously teaches the abrasion resistant particles being in a plane (*See paras. 20-31 where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*).

**10.** Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of O'Dell et al. (US 5,545,476) and Jaisle et al. (US 4,473,613).

Dohring ('984) and O'Dell ('476) teach the paper discussed above, however, fail to expressly disclose the paper having a weight of 20 to 60 g/m<sup>2</sup> and being filled with an acrylate.

However, Jaisle ('613) teaches providing an acrylate filled paper having a décor having a weight of 20 to 60 g/m<sup>2</sup> (*See Abstract, col. 2, ll. 52-68. col. 3, ll. 31-37 and col. 4, ll. 35-40.*) for the purpose of providing a material that easy to form, resistant to discoloration, can be printed and is useful in high or low pressure laminates (*See col. 4, ll. 35-40.*).

Therefore it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an acrylate filled paper having the above weight as taught by Jaisle ('613) in Dohring ('984) in order to provide a product that is easy to form, resistant to discoloration, can be printed and is useful in various types of laminates.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of O'Dell et al. (US 5,545,476) and Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Dohring ('984) and O'Dell ('476) teach the paper discussed above, however, fail to expressly disclose the silane adhesion promoter being an amino silane adhesion promoter.

However, Shirono ('529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an amino silane adhesion promoter as taught by Shirono ('529) in Dohring ('984) in order to provide a paper having particles with increased adsorption capacity.

**12.** Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring et al. (US 2003/0138600) in view of O'Dell et al. (US 5,545,476) and Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Dohring ('600) and O'Dell ('476) teach the paper discussed above, however, fail to expressly disclose the silane adhesion promoter being an amino silane adhesion promoter.

However, Shirono ('529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an amino silane adhesion promoter



as taught by Shirono ('529) in Dohring ('600) in order to provide a paper having particles with increased adsorption capacity.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

**13.** In response to Applicant's arguments (*See pp. 4-7 of Applicant's Paper filed 8/4/2009.*) regarding the 35 USC 102 rejections, it is noted that all 35 USC 102 rejections have been withdrawn, thus, all arguments regarding such are moot.

**14.** In response to Applicant's arguments (*See pp. 4-7 of Applicant's Paper filed 8/4/2009.*) regarding the new limitations of the new claims including new independent claim 19, it is noted that Applicant's arguments are substantially directed to the new claims and new limitations. The new limitations and claims are discussed above. A new reference is cited that teaches the new coating limitations.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brent T. O'Hern/  
Examiner, Art Unit 1794  
September 28, 2009